

REMARKS/ARGUMENTS

Applicant has received the Office Action dated July 17, 2007, in which the Examiner: 1) objected to claims 11 and 12; 2) rejected claim 4 under 35 U.S.C. § 112, 2nd paragraph, as allegedly indefinite; 3) rejected claims 13 and 15-17 under 35 U.S.C. § 102(b) as allegedly anticipated by Sawada (U.S. Patent No. 6,907,470); 4) rejected claims 1-12 under 35 U.S.C. § 103(a) as allegedly obvious under Shabtay (U.S. Pub. No. 2004/0047336) in view of Rodeheffer (U.S. Pub. No. 20050036500); and 5) rejected claim 14 under 35 U.S.C. § 103(a) as allegedly obvious in view of Sawada.

With this Response, Applicant amends claims 1, 4, 7 and 10-15. Based on the amendments and arguments herein, Applicant respectfully submits that all pending claims are in condition for allowance.

I. OBJECTIONS TO CLAIMS 11-12

The Examiner objected to claims 11-12 based on informalities. In accordance with the Examiner's request, Applicant has amended claims 11-12 to correct these informalities. Therefore, Applicant respectfully requests that the Examiner remove these objections.

II. REJECTIONS UNDER 35 U.S.C. § 112, 2ND PARAGRAPH

The Examiner rejected claim 4 under 35 U.S.C. § 112, 2nd paragraph, as allegedly indefinite. Specifically, the Examiner believes that the use of the word "or" renders claim 4 indefinite. Applicant disagrees with the Examiner and respectfully submits that use of the word "or" in a claim (*e.g.*, claim 4) does not automatically render that claim indefinite. Breadth of a claim does not constitute indefiniteness. MPEP § 2173.04. In particular, "[i]f the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." *Id.*

Although Applicant believes that use of the word "or" as in claim 4 comports with 35 U.S.C. § 112, 2nd paragraph, Applicant nevertheless amends claim 4 to remove the term "or" in the interest of compact prosecution, since

removal of the term “or” does not narrow the scope of the claims. Because the term “or” has been removed, Applicant kindly requests that the Examiner remove this rejection.

III. REJECTIONS UNDER 35 U.S.C. § 102(b)

The Examiner rejected claims 13 and 15-17 under 35 U.S.C. § 102(b) as allegedly anticipated by Sawada. As amended, claim 13 requires “[a] switch monitoring a port for a link down event or a link up event, . . . said link up event indicative of a newly established link from the switch to [an] entity.” Claim 13 further requires “if the switch determines that [a] packet is to be routed out through said port associated with a detected link up event, the switch routing the packet through said port.”

Sawada fails to teach or suggest this combination of limitations. Instead of teaching the “monitoring” of a port for a link up event, as in claim 13, Sawada teaches that a port having a status of “disconnected” changes its status to “connected” by way of a directed packet. Col. 2, ll. 10-21; col. 9, l. 62 – col. 10, l. 20. More specifically, Sawada’s processor is adapted to receive a directed packet which instructs the processor to change the status of a “disconnected” port to “connected.” *Id.* Unlike Sawada, claim 13 requires that the status of a port changes to “connected” by “monitoring a port” for a “link up event,” where the “link up event [is] indicative of a newly established link from the switch to [an] entity.” Claim 13 further requires that once a port’s status is changed to “connected” in this manner, the switch may route packets through that port. Because Sawada’s method of connection is different from that of claim 13, Sawada certainly cannot disclose this limitation. Independent claim 13 and dependent claims 14-17 are patentable over Sawada for at least these reasons.

IV. REJECTIONS UNDER 35 U.S.C. § 103(a)

A. Claims 1-12

Regarding the rejections of claims 1-12 as allegedly obvious over Shabtay in view of Rodeheffer, Applicant respectfully submits that Rodeheffer is

disqualified as prior art under the provisions of 35 U.S.C. § 103(c)(1), which states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

On October 27, 2003¹, the filing date of the instant application, both Rodeheffer and the instant application were commonly owned by the Hewlett-Packard Development Company, L.P. (hereinafter "Owner"). The Rodeheffer reference was assigned to Owner on August 1, 2003 by inventor Rodeheffer and on August 14, 2003 by inventors Lillibridge and Thekkath (Reel/Frame014404/0252). The instant application was assigned to Owner on October 22, 2003 (Reel/Frame 014644/0622). The Examiner has concluded that Rodeheffer constitutes prior art under 35 U.S.C. § 102(e). Thus, because Owner owned both the § 102(e) reference Rodeheffer and the instant application on October 27, 2003, Rodeheffer is disqualified as prior art for purposes of an obviousness rejection of the present claims. Shabtay does not satisfy the deficiencies created by the disqualification of Rodeheffer. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 1-12 under 35 U.S.C. § 103(a) as allegedly obvious under Shabtay in view of Rodeheffer.

B. Claim 14

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as allegedly obvious in view of Sawada. However, as demonstrated above, claim 14 depends on independent claim 13, which is patentable over Sawada. Thus, claim 14 is patentable over Sawada for at least this reason.

¹ For purposes of this Response, Applicant's filing date of October 27, 2003 is presumed to be the latest date on which the claimed inventions were made (until shown otherwise by Applicant).

V. CONCLUSION

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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